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EXAMINER	
CALLAHAN, PAUL E	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/657,287	CLARK ET AL.	
	Examiner	Art Unit	
	Paul Callahan	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *25-28* is/are allowed.

6)☒ Claim(s) *1-7,13-16,19,21,22,24 and 29-34* is/are rejected.

7)☐ Claim(s) *8-12, 17, 18, 20, 23* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7-2-07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 were pending in the instant application at the time of the previous Office Action, mailed April 5, 2007. By the latest amendment, filed July 2, 2007, new claims 31-34 are added. Therefore claims 1-34 are pending and have been examined.

Response to Arguments

2. The Applicant's arguments with respect to the rejections of claims 16-24 under 35 USC 101 are persuasive and the rejections are withdrawn.

The Applicant's argument with respect the rejection of claim 20 under 35 USC Sec. 102(b) as anticipated by Ryota has been fully considered and is persuasive and the rejection is withdrawn.

Applicant's arguments with respect to claims 1-7 have been fully considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 16, 19-22, 24, 29 and 30 been fully considered but they are not persuasive. The applicant argues that the rejections of these claims under 35 USC Sec. 102(b) as anticipated by Ryota are improper because Ryota fails to teach the feature of recording a multi-digit security code into a motion picture with each recorded symbol representing a digit of the code. Yet such a feature is not recited in these claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues further in traverse of the rejection of claim 29 as anticipated by Ryota by asserting that Ryota fails to teach the feature of a separate predetermined pattern or defects for each of a plurality of characters. However, the Examiner maintains that Ryota teaches such at, for example, paragraph 0095 and 0096. The Applicant argues that Ryota cannot teach this feature since a random number generation process is used to create the pattern containing the watermark information and that therefore the same random number may be generated twice. However, the Examiner notes that given the relatively large number of random values generated by all industry standard random number generators compared to the far smaller number used to watermark a film in the system of Ryota, the probability of two congruent values being generated in the watermarking process of Ryota is essentially zero. Ryota teaches such at paragraphs 0069 and 0069.

The Applicant argues in traverse of the rejection of claim 7 as anticipated by Ryota by asserting Ryota fails to teach the feature of a unique identifier for each print of a film. However, Ryota teaches that the copyright information may be encrypted or hashed prior to insertion, and therefore the watermark will represent a different number for each print of a film.

The Applicant asserts that the rejections of claims 2, 16, 24 and 29 are improper because Ryota fails to teach the feature of marks that "look like defects." However, the dot patterns used by Ryota to carry the watermark information as taught in paragraph 0095 constitute such. Such a pattern will also appear as a defect in the film. The applicant further argues that Ryota teaches at paragraph 0051, a watermark that will

appear as recognizable characters under magnification of a static image. However, the mark will appear as a defect to the unaided eye. The applicant's claims do not specify a magnified static image frame be perceived as containing a defect.

The Applicant asserts that the rejection of claim 3 as anticipated by Ryota is improper because Ryota fails to teach that the mark will be a pattern that represents alphanumeric data. However, the Examiner maintains that such is indeed taught at figs. 10, 17-19, and paragraphs 0076, 0078, and 0095.

The Applicant asserts that the rejection of claim 4 as anticipated by Ryota is improper because there is no teaching of a pattern composed of specks that are small and widely spaced so as to be unobtrusive. However the Examiner maintains that such is indeed taught by Ryota at paragraph 0049 and 0051 where the mark is taught as not susceptible to loss due to compression techniques.

Claim Objections

3. Claim 30 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 30 recites a preamble in which it is dependent on itself.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 16, 19, 21, 22, 24, 29, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryota et al., International Application EP 0 899 688 A3.

As for claim 16, Ryota teaches a motion picture film copy bearing a coded identification number with a plurality of different components (fig. 2; [0001], [0033], fig. 10, 17, 18, 19, [0076], [0078], [0095]), each of said components being composed of one or more small, separated marks resembling defects and located in the visible portion ([0051) of a separate one of the frames of said film copy ([0034], 0035]).

As for claim 19, Ryota teaches a film copy as in Claim 16 in which each of said components is repeated at least once in an adjacent frame before a second component is recorded ([0097]).

As for claim 21, Ryota teaches a film copy as in Claim 16 in which said separate ones of said frames are located a substantial distance from the other of said frames ([0097]).

As for claim 22, Ryota teaches a motion picture film print bearing coded information (fig. 2; [0001], [0033]), said coded information being represented by a plurality of small marks having the appearance of defects formed into code symbols representing said coded information defects ([0051]: a magnifying glass must be used to discern that the mark is a coding symbol).

As for claim 24, Ryota teaches a film print as in Claim 22 in which said marks comprise a plurality of groups of defects, each arranged in a predetermined pattern or shape representing a separate digit of the print number of the film ([0095]).

As for claim 29, Ryota teaches a method of recording a plurality of coded alphanumeric in a motion picture film recording ([0095]), said method characters comprising; (a) recording a separate predetermined pattern or defects in the sight area of one or more frames of said recording to represent each of a plurality characters ([0095]), and (b) storing the location in said film recording of each of said patterns ([0051]).

As for claim 30, Ryota teaches a method as in Claim 30 in which said defects are small specks, each pattern appearing in one of widely separated frames to form an alphanumeric sequence representing the code number of said film ([0095]).

6. Claims 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Antonellis et al. US 7,206,409. Antonellis teaches:

As per claim 31, a motion picture security code application system (abstract) comprising: (a) a recording device for recording code symbols on a motion picture record medium (col. 6 lines 12-33); and (b) a control system for controlling said recording device to cause it to record on said record medium information comprising a plurality of separate coded symbols (col. 3 lines 10-20, col. 6 lines 12-34, 55-63, col. 7 lines 45-50, col. 10 lines 30-44), each said symbol comprising one or more small marks which look like defects (col. 7 lines 1-8).

As per claim 32, a motion picture record medium having motion picture content recorded (abstract) thereon bearing a coded identification number with a plurality of separate coded symbols, each symbol representing a digit of a multi-digit security code and each symbol being recorded in a separate frame of the motion picture content recorded on said record medium (col. 3 lines 10-20, col. 6 lines 12-34, 55-63, col. 7 lines 45-50, col. 10 lines 30-44).

As per claim 33, the motion picture record medium of claim 32, wherein the separate coded symbols are represented by a plurality of small marks having the appearance of defects in the motion picture content (col. 7 lines 1-8).

As per claim 34, the motion picture record medium of claim 32, wherein the record medium is a DVD (col. 5 lines 40-45)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryota.

As for claim 13, Ryota fails to explicitly teach a system as in Claim 1 in which said recording equipment includes fiber-optic cables with an exit focusing lens and a controlled light source for sending light through selected ones of said fiber-optic cables to record a pattern of light spots on said record medium and thereby form one of said symbols. However, Official Notice may be taken that that use of such features in recording equipment is old and well known in the art. Therefore it would have been

obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ryota. It would have been desirable to do so since this would allow for the use of standard film recording apparatus to encode the watermarked code symbols.

As for claim 14, Ryota does not explicitly teach a system as in Claim 13 in which said recording equipment includes means for synchronizing the formation of said spots with the movement of said record medium through a copy recorder for recording medium. However, Official Notice may be taken that that use of such features in recording equipment is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ryota. It would have been desirable to do so since this would allow for the use of standard film recording apparatus to encode the watermarked code symbols.

As for claim 15, Ryota teaches a system as in Claim 14 in which said record medium is motion picture film and said copy recorder is a film printer (fig. 2; [0001], [0033]).

9. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryota and Antonellis et al., US 7,206,409.

As for claim 1, Ryota teaches a moving picture security code application system (Para. 57) comprising: (a) code symbol recording equipment for recording code symbols on a moving picture record medium (fig. 2; [0001], [0033]), and (b) a control system for controlling said recording equipment to cause it to record on said record medium (fig. 2, [0023]) information comprising a plurality of separate coded symbols ([0043], [0049]), each being recorded in a separate frame of said moving picture ([0033], [0034], [0035]). Ryota fails to explicitly teach each symbol representing a digit of a multi-digit security code. However, Antonellis does teach this feature (col. 3 lines 10-20, col. 6 lines 12-34, 55-63, col. 7 lines 45-50, col. 10 lines 30-44). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Ryota. It would have been desirable to do so since this would increase the fidelity of the watermarking process and prevent unauthorized removal of the mark.

As for claim 2, Ryota teaches a system as in Claim 1 in which each of said code symbols is located in a visible portion of said frame, said symbol comprising one or more small marks which look like defects ([0051]: a magnifying glass must be used to discern that the mark is a coding symbol).

As for claim 3, Ryota teaches a system as in Claim 1 in which each of said symbols is made of a plurality of specks formed into a pattern representing an

alphanumeric character (fig. 10, 17, 18, 19, [0076], [0078], [0095]).

As for claim 4, Ryota teaches a system as in Claim 3 in which each of said specks has a size large enough to avoid elimination by the data compression routine of a video camera used to make a copy of the motion picture recorded on said record medium, said specks being relatively small and widely spaced from one another so as to be unobtrusive ([0049]).

As for claim 5, Ryota teaches a system as in Claim 1 in which each of said symbols is recorded in a plurality of different adjacent frames prior to the location of the next component of said multi-digit security code ([0097]).

As for claim 6, Ryota teaches a system as in Claim 1in which the plurality of separate coded symbols is recorded a plurality of times at spaced-apart locations on said record medium ([0034], 0035]).

As for claim 7, Ryota teaches a system as in Claim 1 in which each of said symbols comprises a representation of one digit of a multi-digit print identification number, and a unique identification number is provided for each of a plurality of prints of a motion picture ([0095]: the copyright control information is chosen pseudo-randomly and therefore each will be unique to that print).

Allowable Subject Matter

10. Claims 25-28 are allowed.

11. Claims 8-12, 17, 18, 20, and 23, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Callahan

/Paul Callahan/

September12, 2007

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER